



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

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SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
05/236,290	00/23/70	JUNGE	BAYER AG

SPRUNG, FELICE, HORN, LYNCH & FORNER
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NEW YORK, N.Y. 10016

EXAMINER	
COMPLAINT	
ART UNIT	PAPER NUMBER
121	32

DATE MAILED: 09/10/05

This is a communication from the examiner in charge of your application.

COMMISSIONER OF PATENTS AND TRADEMARKS

- ☒ This application has been examined ☒ Responsive to communication filed on 9-23-85 ☒ This action is made final.

A shortened statutory period for response to this action is set to expire THREE month(s), _____ days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- | | |
|---|---|
| 1. <input checked="" type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 2. <input type="checkbox"/> Notice re Patent Drawing, PTO-948. |
| 3. <input type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449 | 4. <input type="checkbox"/> Notice of informal Patent Application, Form PTO-152 |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474 | 6. <input type="checkbox"/> _____ |

Part II SUMMARY OF ACTION

1. ☒ Claims 5-11, 14, 16, 18, 24-53 are pending in the application.
Of the above, claims 33, 39, 44, 46 are withdrawn from consideration.
2. ☐ Claims _____ have been cancelled.
3. ☒ Claims 50 are allowed.
4. ☒ Claims 5-10, 14, 18, 24-32, 34-38, 40-43, 45, 47-49, 51 are rejected.
5. ☒ Claims 11, 16, 52, 53 are objected to.
6. ☐ Claims _____ are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings which are acceptable for examination purposes until such time as allowable subject matter is indicated.
8. ☐ Allowable subject matter having been indicated, formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on _____. These drawings are ☐ acceptable; ☐ not acceptable (see explanation).
10. ☐ The ☐ proposed drawing correction and/or the ☐ proposed additional or substitute sheet(s) of drawings, filed on _____, has (have) been ☐ approved by the examiner. ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed _____, has been ☐ approved. ☐ disapproved (see explanation). However, the Patent and Trademark Office no longer makes drawing changes. It is now applicant's responsibility to ensure that the drawings are corrected. Corrections MUST be effected in accordance with the instructions set forth on the attached letter "INFORMATION ON HOW TO EFFECT DRAWING CHANGES", PTO-1474.
12. ☐ Acknowledgment is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received
☐ been filed in parent application, serial no. _____; filed on _____.
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

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Applicants' amendment filed August 23, 1985 contains numerous errors under 37 CFR 1.121. It appears that the *partially* entered amendment of June 11, 1979 has not been considered by counsel because many changes effected thereby are again requested. For example, note the claim dependences in claims 24, 25, 27, 29, 34-36 and 38. Claim 5 never depended on claim 1; rather it depends on claim 4. Claim 39 depends on 18 and not on 17. Claim 10 contains omissions and spelling errors.

In claim 47 the "(a)" must immediately follow the first phenyl or the claim loses meaning. There are errors in the substituents R₂ and R₃ in claims 47 and 48. See paper No. 7, page 4 and note that claims 24, 25, 27, 29, 34-36 and 38 are "twice amended", since certain changes were made after the June 11, 1979 amendment, e.g. claim dependences and the spelling of "hyperlipaemia" in claim 29. A carefully corrected amendment is required.

The following is a quotation of 35 U.S.C. 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said sub-

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ject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Claims 5-10, 18, 24-32, 34-38, 40-43 and 47 are rejected under 35 U.S.C. 103 as being unpatentable over Murai et al, U.S. Patent 4,182,767, of record (Murai).

The recitation of C₅ alkyl for R₁ reads on adjacent homologs of the Murai compounds. Note that the C₁-C₄ progression in Murai renders obvious both C₅ and C₆ alkyl; In re Riden, 138 USPQ 112.

Claims 5-10, 14, 18, 24-32, 34-38, 40-43, 47 and 51 are rejected under 35 U.S.C. 103 as being unpatentable over Matsumura et al (Matsumura), the winning party in Interference No. 100,397.

Applicant's arguments filed August 23, 1985 have been fully considered but they are not deemed to be persuasive.

Obvious variants of the propylphenyl compound must be excluded from the claims, along with the phenylpropyl compound itself.

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Claim 45 is rejected under 35 U.S.C. 103 as being unpatentable over Saeki for reasons of record.

It has never been established that XIII is the product of acid hydrolysis of VIII. The UV data show a pyridine substituted by hydroxyl(s), possibly three hydroxyls. Hydrogenation of the compound would give the instant compounds when R₂ is not hydrogen. Thus loss and reintroduction of hydroxyls is not at issue. The process^s are entirely analogous.

Claims 5-9, 18, 24-32, 34-38, 40-43, 45 and 47-49 are for reasons of record rejected under 35 U.S.C. 112, first and second paragraphs, as the claimed invention is not described in such full, clear, concise and exact terms as to enable any person skilled in the art to make and use the same, and/or for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Counsel is ~~confu~~^{sing} basis with support. The first alkyl (page 7, line 2 of the amendment should read "C₅-C₃₀ alkyl" to avoid confusion with the newly added alkyl phrase. The "a" must be ^{placed} immediately after the first phenyl. Phenylacetylcarbonyl still appears in claim 49. What does substitution by "sulfur" mean in claims 47 and 49? Claim 48 would be allowable upon correction of errors.

The restriction requirement has been previously made FINAL and can be withdrawn only by petitioning the

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Commissioner. Accordingly, claims 33, 39, 44 and 46 stand withdrawn; 37 CFR 1.142(b).

Claims 11, 16, 52 and 53 stand objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim 50 is allowed.

Applicant's amendment necessitated the new grounds of rejection. Accordingly, THIS ACTION IS MADE FINAL. See MPEP 706.07(a).

Applicant is reminded of the extension of time policy set forth in 37 CFR 1.136(a). The practice of automatically extending the shortened statutory period an additional month upon the filing of a timely first response to a final rejection has been discontinued by the Office. See 1021 TMOG 35.

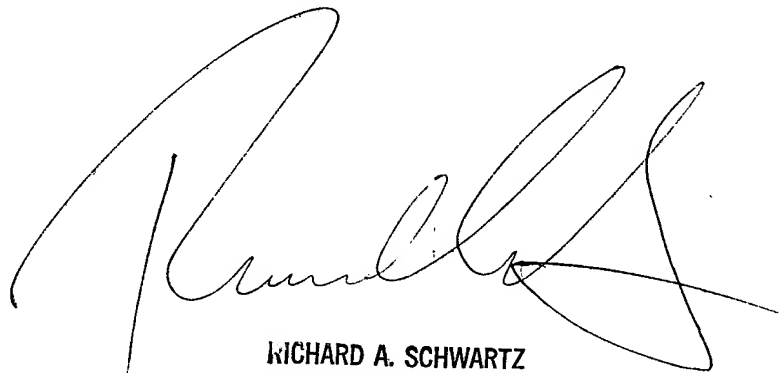
A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 CFR 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

Schwartz:ebw

A/C 703

557-3920

9/12/85



RICHARD A. SCHWARTZ
PRIMARY EXAMINER
ART UNIT 121